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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/529,255	04/11/2000	TAKANORI SHINOKI	2000-0465A	5270

7590 03/04/2004

WENDEROTH LIND & PONACK  
2033 K STREET NW  
SUITE 800  
WASHINGTON, DC 20006

EXAMINER

MORRIS, TERELL H

ART UNIT	PAPER NUMBER
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1771

DATE MAILED: 03/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/529,255

Applicant(s)

SHINOKI ET AL.

Examiner

John J. Guarriello

Art Unit

1771

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 7/9/2003, 12/9/2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 9-18 is/are pending in the application.
- 4a) Of the above claim(s) 11-16 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 9-11, 17, 18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

15. The Examiner acknowledges responses of 7/22/2003, and the amendment of 12/9/2003.

16. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

#### ***Claim Rejections - 35 USC § 112***

17. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

18. Claims 9-11, 17, 18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

For claim 9, lines 1-11, the recitation "said support member comprising a nonwoven fabric" with the stated properties, is vague and indefinite because this gives no notice as to what constitutes infringement upon the instantly claimed invention. It should be noted that claims merely setting forth physical characteristics desired in an

article, and not setting forth specific structure and/or compositions which would meet such characteristics, either in the claim or the specification, are invalid as vague, indefinite, and functional, since it recites compounds by what is desired that they do, rather than what they are. It is the Examiner's position that it is unclear as to what the scope of the invention of which Applicant intends to claim, see Ex parte Slob (BdPatApp&Int) 157, USPQ 172. The claim fails to set forth any structure by which a comparison with the art can be made. As such, those practicing in this field would not be able to determine if their products infringe without undue experimentation.

***Claim Rejections - 35 USC § 103***

19. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

20. Claims 9-11, 17, 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shinjou et al. 4,795,559.

Rejection is maintained substantially as in paper of 12/9/2003.

Applicant's arguments regarding difficulty in preparation of the membrane with smooth surface, have been considered, but it is the Examiner's position that the burden is upon applicant to show that the reference, '559, does not, see *In re Fitzgerald et al.* 619 F.2d 67, 205 USPQ 594 (CCPA 1980). Also, a membrane is not being claimed, merely a substrate therefore. Further, the comment of the attorney cannot be taken as evidence. Additionally, these comments do not relate to any feature currently claimed such as to show distinction of the claimed invention from the prior art.

Shinjou describes a semipermeable membrane support, (see abstract). Shinjou describes the support is a nonwoven fabric, (see abstract). Shinjou describes is made of polyester fibers, (see abstract). Shinjou describes air permeability of 0.1 to 5.00 cc/square cm./sec, (see abstract). Shinjou describes the support contains 20-80% of polyester fiber, (column 2, lines 57-60). Shinjou describes a denier of 1 to 3, (column 2, lines 60-63). Shinjou describes strength and elongation, see Table I, (column 7 and 8). Shinjou differs from the claimed invention because it is silent about heat shrinkage.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to optimize the heat shrinkage value since Shinjou describes the basic components and the ranges overlap the claimed invention.

21. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

22. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John J. Guarriello whose

telephone number is 571-272-1476. The examiner can normally be reached on 8 hr. flex.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel H. Morris can be reached on 571-272-1478. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



John J. Guarriello  
Patent Examiner  
Art Unit 1771

February 13, 2004  
February 26, 2004



TERREL MORRIS  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1700